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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/864,976   | 05/24/2001  | Evan E. Koslow       | 369.7217USU         | 3444             |
| 30546  | 7590        | 09/20/2005           | EXAMINER            |                  |
| GARY L. WAMER<br>KX INDUSTRIES, L.P., 269 SOUTH LAMBERT ROAD<br>ORANGE, CT 06477 |             |                      | BOYD, JENNIFER A    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |

1771

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/864,976

Applicant(s)

KOSLOW, EVAN E.

Examiner

Jennifer A. Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Applicant's Amendments and Accompanying Remarks, filed June 24, 2005, have been entered and have been carefully considered. Claim 10 is amended and claims 10 – 16 are pending. In view of Applicant's amendment, the Examiner has amended the previously applied rejection below. The invention as currently claimed is unpatentable for reasons herein below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 10 – 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 11 – 16 are rejected as being dependent on claim 10.
5. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which

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it is most nearly connected, to make and/or use the invention. On page 5 of the Specification, Applicant indicates that the spontaneous conversion of an immobilized bonded mixture of a relatively thin, planar laminate of SAP particles into three-dimensional channels is unique and unexpected. Applicant asserts that SAP particles, which do not possess this property when processed in accordance with the same process as is the SAP composite of the present invention, do not exhibit this enhanced liquid absorption property when brought into contact with liquid. Applicant indicates that one particular grade of SAP in which this property is observed, is SAP grade SP-1224 available from Stockhausen Corporation. The Examiner asserts that this particular grade of SAP possesses certain physical and/or chemical characteristics which causes the spontaneous channel-forming property not found in other SAP. Because Applicant has failed to provide a generic description of SP-1224, no guidance or insight has been provided which would allow one skilled in the art to determine which types of SAP particles would exhibit this property and which SAP particles would not exhibit this property. According to *In re Wands*, enablement is a question as to whether the experimentation needed to practice the invention is undue or unreasonable. The Examiner asserts that in order to practice the invention of the Applicant it would require undue experimentation in order to determine which SAP particles would possess this unique and unexpected phenomena and which particles would not possess such a phenomena. Although Applicant has provided one particular grade of SAP (SP-1224) which exhibits these properties, the claim scope is uncertain since the trade name cannot be used properly to identify any particular material or product. The chemical nature of SP-1224 may change over time and which point it would be unclear as to whether SP-1224 would possess the unique and unexpected properties or which SAP particles could be used as an alternative.

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Additionally, SP-1224 may become unavailable and in order to practice the invention, undue experimentation would be required to practice Applicant's invention.

***Claim Rejections - 35 USC § 102/103***

6. Claims 10 – 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Koslow (US 6,015,608).

Koslow is directed to a liquid absorbent pad with anti-gel block laminate (Title).

Koslow teaches a liquid absorbent pad as seen in Figure 1 comprising an outer layer 10 of a liquid impervious material as required by claim, such as a thin plastic film or membrane, having an outer surface and inner surface 12. Mounted on the inner surface 12 of the outer layer 10 are a plurality of laminate segments, such as strips 14 (a-c), separated from one another by spaces 22 creating the Applicant's "channels". Each of the strips includes a bottom layer 16 of tissue, an upper layer 18 of tissue, and an intermediate layer 20 of super-absorbent polymer particles bonded to the bottom and upper tissue layers by thermoplastic binder particles, creating the "bonded mixture". The "bonded mixture" has admixture of super-absorbent polymer particles and much smaller particles of thermoplastic binder (column 1, lines 30 – 35). The super-absorbent polymer particles in the intermediate layer "channels" absorb the liquid. Mounted on the laminate strips 14 is a liquid acquisition layer 24. The acquisition layer 24 may be of any material currently used for this purpose and known to those skilled in the art such as an air laid medium. The outer layer 10 in combination with the bottom layer 16 of tissue segments are equated to Applicant's "first substrate". The liquid acquisition layer in combination with the upper layer 18 of tissue are equated to Applicant's "second substrate". An optional liquid-

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permeable skin-contacting spun-bonded medium 26 is provided, equated to Applicant's "liquid permeable acquisition layer" (column 2, lines 29 – 65). The composite will absorb liquid when used as a diaper or in feminine hygiene products (column 1, lines 5 – 7), which is placed close to the body, thus adjacent to the liquid source. It should be noted that it has been held that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (1961). The limitations that describes the physical structure of the composite is not given patentable weight since it does not affect the method in a manipulative sense. It is suggested to add an additional step of "providing a first substrate and bonded mixture..." before the step of "placing a composite adjacent to a liquid source..." .

7. Claims 10 – 16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dutkiewicz (US 6,562,742).

Dutkiewicz is directed to a high-performance absorbent structure (Title).

Dutkiewicz teaches an absorbent material which can comprise three layers wherein at least one layer comprises SAP particles placed in narrow lanes along the absorbent core (columns 3 and 4). See Figures 1a – 1d. Dutkiewicz teaches that the discrete placement of SAP particles allows for better containment of the particles, facilitates flow of liquid in the z-

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direction, because of the presence of areas with little or no SAP, and allows for easier flow and wicking of the fluid along the length of the core (column 4, lines 1 – 12). Dutkiewicz notes that the absorbent structure has a substantially dry liquid-accepting surface after receiving a quantity of liquid (Abstract). It should be noted that it has been held that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (1961). The limitations that describes the physical structure of the composite is not given patentable weight since it does not affect the method in a manipulative sense. It is suggested to add an additional step of “providing a first substrate and bonded mixture...” before the step of “placing a composite adjacent to a liquid source...”.

### ***Response to Arguments***

8. Applicant's arguments filed June 24, 2005 have been fully considered but they are not persuasive.

Applicant argues that Koslow '608 does not teach that the three-dimensional array of elongated channels are formed in the composite when contacted with liquid. As stated above, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (1961). The Examiner

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has given weight to the manipulative steps of “placing a composite adjacent to a liquid source”, “acquiring the liquid into the composite along the three-dimensional array of elongated channels” and “absorbing the liquid by means of at least some of said bonded mixture”. The remaining alleged method steps are merely descriptive of the operation and function of the composite. The properties of the composite when placed adjacent to a liquid source is a characteristic of the composite itself and cannot be considered to constitute a manipulative step distinct from that of placing a composite adjacent to a liquid source.

Applicant argues that Dutkiewicz '742 does not teach that the three-dimensional array of elongated channels are formed in the composite when contacted with liquid. As stated above, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (1961). The Examiner has given weight to the manipulative steps of “placing a composite adjacent to a liquid source”, “acquiring the liquid into the composite along the three-dimensional array of elongated channels” and “absorbing the liquid by means of at least some of said bonded mixture”. The remaining alleged method steps are merely descriptive of the operation and function of the composite. The properties of the composite when placed adjacent to a liquid source is a characteristic of the composite itself and cannot be considered to constitute a manipulative step distinct from that of placing a composite adjacent to a liquid source.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer Boyd

September 14, 2005

  
**Ula C. Ruddock**  
Primary Examiner  
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